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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,252	06/07/2001	Dominic P. Behan	AREN-0240	8181

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12/18/2002

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EXAMINER

BASI, NIRMAL SINGH

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,252

Applicant(s)

Behan et al

Examiner

Nirmal S. Basi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 7, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-100 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction
5 Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit
10 the use of this dedicated Fax number to responses to Written Restrictions.

2. ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1 to 100 are pending in the instant application.

15 I. Claims 1, 3 and 4 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hARE(F313K) , plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

20 II. Claims 5, 7 and 8 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hARE-4(V223K) , plasmid

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comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

III. Claims 9, 11 and 12 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hARE-5(A240K) , plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

IV. Claims 13, 15 and 16 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hGPCR14(L275-K), plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

V. Claims 17, 19 and 20 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hGPCR27(C283K), plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

VI. Claims 21, 23 and 24 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hARE-1 (E232K) , plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

VII. Claims 25, 27 and 28 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hARE-2(G285K) , plasmid

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comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

VIII. Claims 29, 31 and 32 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hPPR1(L239K), plasmid
5 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

IX. Claims 33, 35 and 36 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hG2A(K232A) , plasmid
10 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

X. Claims 37, 39 and 40 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hRUP3(L224K) , plasmid
comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

15 XI. Claims 41, 43 and 44 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hRUP5(A236K), plasmid
comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

20 XII. Claims 45, 47 and 48 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hRUP6(N267K) , plasmid

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comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XIII. Claims 49, 51 and 52 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hRUP7(A302K), plasmid
5 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XIV. Claims 53, 55 and 56 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hCHNU(V236K) , plasmid
10 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XV. Claims 57, 59 and 60 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hMC4(A244K) , plasmid
comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

15 XVI. Claims 61, 63 and 64 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hCHN3(S284K) , plasmid
comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

20 XVII. Claims 65, 67 and 68 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hCHN6(L352K) , plasmid

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comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XVIII. Claims 69, 71 and 72 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hCHN8(N235K) , plasmid
5 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XIX. Claims 73, 75 and 76 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hH9(F236K) , plasmid
10 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XX. Claims 77, 79 and 80 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hAT1(F239K) , plasmid
comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

15 XXI. Claims 77, 79 and 80 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hAT1(N111A), plasmid
comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

20 XXII. Claims 77, 79 and 80 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hAT1(AT2K255IC3), plasmid

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comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XXIII. Claims 77, 79 and 80 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hAT1(A243+), plasmid
5 comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XXIV. Claims 81, 83, 84 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hRUP4(V272K), plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass
10 23.5.

XXV. Claims 85, 87 and 88 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hCHN9(G223K), plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

15 XXVI. Claims 89, 91 and 92 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hARE-S(A240K), plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

20 XXVII. Claims 93, 95 and 96 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hGPR38(V297K),

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plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XXVIII. Claims 97, 99 and 100 in so far as they encompass an isolated cDNA encoding a non-endogenous human G protein-coupled receptor comprising hTDAG8(122583K),
5 plasmid comprising a vector and said cDNA and host cell comprising said cDNA classified in class 536, subclass 23.5.

XXIX. Claim 2 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hARE(F313K), classified in class 530, subclass 350.

10 XXX. Claim 6 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hARE-4(V223K), classified in class 530, subclass 350.

XXXI. Claim 10 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hARE-5(A240K), classified in class 530,
15 subclass 350.

XXXII. Claim 14 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hPGCR14(L275-K), classified in class 530, subclass 350.

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XXXIII. Claim 18 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hGPCR27 (C283K), classified in class 530, subclass 350.

5 XXXIV. Claim 22 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hARE-1(E232K), classified in class 530, subclass 350.

XXXV. Claim 26 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hARE-2(G285K), classified in class 530, subclass 350.

10 XXXVI. Claim 30 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of PPRI(L239K), classified in class 530, subclass 350.

15 XXXVII. Claim 34 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hG2A(K232A), classified in class 530, subclass 350.

XXXVIII Claim 38 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hRUP3(L224K), classified in class 530, subclass 350.

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XXXIX. Claim 42 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hRUP5(A236K), classified in class 530, subclass 350..

5 XL. Claim 46 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hRUP6(N267K), classified in class 530, subclass 350.

XLI. Claim 50 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hRUP7(A302K), classified in class 530, subclass 350.

10 XLII. Claim 54 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hCHN4(V236K), classified in class 530, subclass 350..

15 XLIII. Claim 58 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hHMC4(A244K), classified in class 530, subclass 350.

XLIV. Claim 62 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hCHN3(S284K), classified in class 530, subclass 350.

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XLV. Claim 66 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hCHN6(L352K), classified in class 530, subclass 350.

5 XLVI. Claim 70 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hCHN8(N235K), classified in class 530, subclass 350.

XLVII. Claim 74 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hH9(F236K), classified in class 530, subclass 350.

10 XLVIII. Claim 78 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hAT1(F239K), classified in class 530, subclass 350.

15 XLIX. Claim 78 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hAT1(N111A), classified in class 530, subclass 350.

L. Claim 78 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hAT1(AT2K255IC3), classified in class 530, subclass 350.

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LI. Claim 78 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hAT1 (A243+), classified in class 530, subclass 350.

5 LII. Claim 82 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of RUP4 (V272K), classified in class 530, subclass 350.

LIII. Claim 86 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hCHN9 (G223K), classified in class 530, subclass 350.

10 LIV Claim 90 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hCHN10(L231K), classified in class 530, subclass 350.

15 LV. Claim 94 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hGPR38 (V297K), classified in class 530, subclass 350.

LVI. Claim 98 in so far as it encompasses a non-endogenous version of a human G protein-coupled receptor encoded by the cDNA of hTDAG8(1225K), classified in class 530, subclass 350.

The inventions are distinct, each from the other because:

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The proteins that are inventions XXIX to LVI, the nucleic acids that are inventions I to XXVIII, are fifty-six structurally and functionally distinct chemical compounds each of which can be made and used without any one or more of the other compounds. These compounds are lack a common utility which is based upon a common structural feature which has been
5 identified as the basis for that common utility.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, restriction for examination purposes as indicated is proper. A search of the art for Inventions I-LVI would not be co-extensive with each other. Because the searches required for these inventions are not co-extensive an examination of the materially different,
10 patentably distinct inventions in a single application would constitute a serious burden on the examiner. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the
15 inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

10


Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Nirmal S. Basi
Art Unit 1646
December 10, 2002

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YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600